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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,466	03/23/2000	Frank R. Collart	21416/90042	9908

7590

03/27/2002

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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	20

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☒ is extended to run 4 months or continues to run _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 2/13/02 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

b. ☒ They raise new issues that would require further consideration and/or search. (See Note).

c. ☐ They raise the issue of new matter. (See Note).

d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The proposed amending of clm 4 directed to "designing inhibitors" is a new issue that would require further consideration and/or search. "Developing lead compounds" is a different limitation generally interpretable to include various screening and many other selection methods.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: 4

Claims objected to: 2, 3

Claims rejected: 1 and 5-8

However;

☒ Applicant's response has overcome the following rejection(s): the 112, 1st para, rejections of clms 2, 4, 6, & 8 and the 112, 1st para, rejections of clm 6

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because of reasons of record as discussed further as attached

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☒ The proposed drawing correction ☐ has ☒ has not been approved by the examiner.

☒ Other The proposed drawings as filed are disapproved. See PTO-948 attached. Non-elected clms 9-15 remain pending.

Further Explanation of Item 4 on the attached Advisory Action:

The rejection of claim 7, under 35 U.S.C. § 112, second para., is maintained due to non-entry of the amendment. It is noted, however, that the amending of claim 7 as proposed would have overcome this rejection, if the amendment had been entered.

Applicants' arguments regarding the rejections based on prior art are confusing and non-persuasive because of the difference between the limitations in the claims regarding percent identity and the arguments. For example, applicants argue that only a 35% identity is present for the Chinese hamster IMPDH of Sintchak. It is noted that there is no identity criteria in claim 5. Additionally, the claim 6 35% identity criteria is directed to sequence comparison within a binding pocket and not another comparison. Applicants have not defined what the 35% in their arguments are directed to. The most reasonable and common evaluation of percent identity between two enzymes or sequences is the overall percentage value. Applicants have not stated what the 35% refers to in their arguments. This is a confusing and therefore non-persuasive argument in the remainder of the arguments regarding the prior art rejections.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG

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94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

March 22, 2002

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER